

REMARKS

Favorable reconsideration of this application is requested in view of the above amendments and the following remarks. Claim 1 is amended and claim 53 is newly added. Claims 1-23 and 53 remain actively pending in the case. Support for the amendments can be found on at least pages 11-12. No new matter has been added. Reconsideration of the claim is respectfully requested.

On page 2 of the Office Action, the Office Action states that claims 51 and 52 are drawn to an invention nonelected. In the interest of furthering prosecution, Applicants have cancelled claims 51 and 52 with traverse.

In paragraph 2 on page 3 of the Office Action, claims 1-7 were finally rejected under 35 USC § 103(a) as being unpatentable over Nelson et al. (3,895,220). In paragraph 3 on page 5 of the Office Action, claims 1-14, 16 and 21-23 were finally rejected under 35 USC § 103(a) as being unpatentable over Wentworth (5,547,226) in view of Hicks (5,359,387) and further in view of Johnson et al. (5,060,980). In paragraph 4 on page 9 of the Office Action, claims 17-20 were finally rejected under 35 USC § 103(a) as being unpatentable over Wentworth (5,547,226) in view of Hicks and Johnson et al., and further in view of Kawai et al. (6,043,866). Applicants respectfully traverse the rejections.

Nelson fails to teach or suggest at least one instruction form containing a machine-readable code, the machine-readable code configured to organize a plurality of customer provided hard copy images into categories. As admitted by the Office action, Nelson does not disclose organizing a plurality of images. Rather, Nelson discloses a magnetically encodable envelope insert that can be read while the insert is within an envelope. Col. 1, lines 25-30.

Wentworth fails to remedy the deficiencies of Nelson as Wentworth fails to teach or suggest at least one instruction form containing a machine-readable code, the machine-readable code configured to organize a plurality of customer provided hard copy images into categories. Wentworth merely discloses a filing system for storing, organizing and handling documents. In particular it is directed to a container 11 such as a file cabinet in which hanging folders 12 are provided. Col. 3, lines 22-25. Inside each of these folders documents may be placed. Wentworth also teaches the use of color in which the same color folders contain the same related matter. Col. 3, lines 30-33.

Hicks fails to remedy the deficiencies of Nelson and Wentworth as Hicks also fails to teach or suggest at least one instruction form containing a machine-readable code, the machine-readable code configured to organize a plurality of customer provided hard copy images into categories. Rather, Hicks merely discloses a combined print and order form for ordering an image product package. Marks made on the order form by a user can be machine readable. Col. 4, lines 21-26.

Johnson fails to remedy the deficiencies of Nelson, Wentworth and Hicks as Johnson also fails to teach or suggest at least one instruction form containing a machine-readable code, the machine-readable code configured to cause a scanning device to organize a plurality of customer provided hard copy images into categories. Rather, Johnson merely discloses a system for creating and interpreting a form. Col. 4, lines 9-11.

Thus, it is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the fifth applied prior art reference to Nelson is moot, inasmuch as the combination of Nelson, Wentworth, Hicks, Johnson and Kawai still lack any teaching, disclosure, or suggestion concerning machine-readable code configured to organize a plurality of customer provided hard copy images into categories as previously discussed.

Therefore, in view of the above remarks, Applicants' independent claim 1 is patentable over the cited references. Because claims 2-23 and 53 depend from claim 1 and include the features recited in the independent claim, Applicants respectfully submit that claims 2-23 and 53 are also patentably distinct over the cited references. Nevertheless, Applicants are not conceding the correctness of the Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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